

Commissioner for Patents
Application No. 10/757,290
Response Date: May 1, 2006
Response to Office Action dated March 3, 2006
Page 9

REMARKS

I. Status of the Application.

Claims 1-27 were pending in the above-referenced patent application as filed. In an Office Action dated October 20, 2005, the Examiner required restriction between two sets of claims: Set I consisting of Claims 1-24 and 27, and Set II consisting of Claims 25-26. In a response dated November 4, 2005, the Applicants elected to prosecute Claims 1-24 and 27, without traverse, and Claims 25-26 were withdrawn.

In the Office Action dated March 3, 2006, the Examiner determined that the Applicants need to elect a single disclosed species for prosecution on the merits in the event that no generic claim is held to be allowable. The Examiner identified Claims 1, 19, and 27 as generic claims. The Examiner identified the following species and subspecies:

Species X characterized by a bucking coil;

Species Y characterized by a spider web coil;

Subspecies A characterized by four or more turns in the inner spiral tube; and

Subspecies B characterized by a prime number of turns in the inner spiral tube.¹

In response, the Applicants provisionally elect Species X and Subspecies A, and respectfully traverse.

¹ Subspecies B corresponds to the Examiner's reference that appears at the end of the third full paragraph on page 3 of the Office Action. Although the Examiner used the term "windings" in this reference, through the Examiner's reference to "claim 5" in describing this subspecies the Applicants conclude that the Examiner intended to use the term "turns."

Commissioner for Patents
Application No. 10/757,290
Response Date: May 1, 2006
Response to Office Action dated March 3, 2006
Page 10

II. The Species Election Requirement Should Be Withdrawn.

Applicants respectfully traverse the Examiner's species election requirement on several grounds.

A. Claims are Never Species.

In each case, the Examiner based his identification of the species and subspecies on Applicants' claims. Applicants respectfully submit that this is clearly inconsistent with the instructions of MPEP §806.04(e), which states "Claims are definitions of inventions. Claims are never species." Accordingly, Applicants respectfully submit that Examiner's identification of species and subspecies is improper and should be withdrawn.

B. Subspecies A and B are not Patentably Distinguishable.

Applicants respectfully submit that subspecies A and B are not patentably distinguishable over one another. A determination that an election of a species is necessary must be based on a conclusion that the species are patentably distinct from one another. MPEP §806.04. Moreover, in order to require restriction between claims limited to species, the claims must not overlap in scope. MPEP §806.04(f).

The Examiner determined that subspecies A is characterized by a spiral tube with four or more turns, while subspecies B is characterized by a spiral tube with a prime number of turns. Applicants respectfully submit that a change in the number of turns in the spiral tube does not render subspecies A and B patentably distinguishable from each other. Furthermore, the Applicants respectfully submit that a bulb apparatus may have, for example, a spiral tube with

Commissioner for Patents
Application No. 10/757,290
Response Date: May 1, 2006
Response to Office Action dated March 3, 2006
Page 11

five turns, which would make the bulb apparatus part of both subspecies A and B. Therefore, subspecies A and B overlap in scope and are not mutually exclusive of each other.

III. Provisional Species Election.

Applicants respectfully provisionally elect Species X and Subspecies A for prosecution on the merits in the event no generic claim is held to be allowable. The following is a listing of all claims that were not previously withdrawn and that read on the elected species and subspecies: Claims 1-4, 6-20, 24 and 27.

Commissioner for Patents
Application No. 10/757,290
Response Date: May 1, 2006
Response to Office Action dated March 3, 2006
Page 12

CONCLUSION

In the event Applicants have inadvertently overlooked the need for payment of an additional fee, Applicants conditionally petition therefor and authorize any deficiency to be charged to deposit account 09-0007. When doing so, please refer to the above-listed docket number.

Respectfully submitted,

ICE MILLER LLP



Thomas A. Walsh
Attorney No. 45,196
ICE MILLER LLP
One American Square, Suite 3100
Indianapolis, Indiana 46282-0200
Telephone: (317) 236-5946
Facsimile: (317) 592-4844

Date: May 1, 2006

TAW:njt